

REMARKS

Applicants have amended claims 4, 11, 25, 38, 46, 48, 59, and 61 to advance prosecution. Claims 4-20, 24-48, 59, 61, and 62 are pending.

In the Office Action at page 10, the Examiner indicated that claim 11 is allowed and that claims 7 and 8 would be allowable if rewritten in independent form. Applicants appreciate the indication of allowable subject matter, but, because those claims are rejected in the Office Action at page 6, Applicants respectfully request clarification of the exact status of claims 7, 8, and 11.

Claims 5, 9, 10, 12-20, and 24 were withdrawn from consideration as being allegedly directed to non-elected species. Applicants respectfully request that the Examiner reconsider and withdraw the election of species requirements and examine all of the claims together. In the extensive prosecution of this application prior to the election of species requirements in the previous Office Action dated December 28, 2005, all of the claims were searched and examined together, and six prior Office Actions (dated August 27, 2002; February 25, 2003; July 15, 2003; January 28, 2004; July 28, 2004; and August 9, 2005) were issued considering all of the claims together without any requirement for election of species. The examination history of the present application clearly shows that all of the claims can be examined without serious burden. "If the search and examination of an entire application can be made without serious burden the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). Since there is no showing of serious burden, all of the claims must be examined.

The election of species requirements (and the remarks in the recent Office Action of April 21, 2006) also incorrectly characterize the disclosure and claims. To show one

example,¹ certain exemplary embodiments disclosed in the present application combine subject matter of different alleged species identified by the Examiner. For example, the present specification expressly describes exemplary methods that combine both a mode of scanning using a transfer member and a direct scanning mode where an external body portion is directly scanned with an image scanner. (See, e.g., page 6, line 14, et seq. and also page 21, line 1, et seq.) Accordingly, claims 14-20 should be examined along with all of the other claims because claims 14-20 have a scope encompassing examples that might include a combination of the exemplary subject matter of Figs. 2-5 (which the Examiner characterized as one species) and the exemplary subject matter of Fig. 8 (which the Examiner characterized as another species).

Furthermore, contrary to the Examiner's allegations in the Office Action at page 3, claim 24 should be examined along with all of the other claims, because the subject matter shown in Figs. 2-6 could clearly be used in a method that involves placing a transfer member in contact with an external portion including at least one strand of hair. The subject matter recited in claim 24 is not limited to the exemplary method shown in Figs. 15 and 16.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the election of species requirements and examine claims 5, 9, 10, 12-20, and 24 together with the other pending claims.

¹ Applicants also respectfully disagree with the Examiner's allegation that the Examiner has identified all of the "Species and Subspecies that have been disclosed, enabled and illustrated in the specification." Office Action at page 2. In addition, Applicants do not necessarily agree with or understand the Examiner's allegations relating to "equivalence" or "equivalent." Id.

In the Office Action, claims 4, 7, 8, and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,533,971 to Stess et al. ("Stess").

Claims 4 and 11 are the only independent claims listed in the claim rejection based on Stess. Applicants respectfully request that the Examiner withdraw the claim rejection because Stess does not disclose a transfer member "placed in direct contact with an external body portion," as recited in amended independent claim 4. Stess also does not disclose placing "moldable material [of a transfer member] in direct contact with the skin of the individual," as recited in amended independent claim 11.

Apparently, the Examiner has equated an impression shirt disclosed in Stess with the transfer member recited in claim 4 and the moldable material recited in claim 11. Stess does not disclose or suggest the impression shirt directly contacting an external body portion and/or skin. Col. 5, lines 36-41. In fact, Stess describes in detail the necessity of a thermal insulation layer and how to prevent direct contact with the impression shirt material. See., e.g., col. 3, lines 29-40, 58-67; col. 4, lines 54-67. Thus, not only does Stess fail to teach placing a transfer member or moldable material in direct contact with an external body portion/skin, the reference actually teaches away from any such contact.

Stess also does not disclose "scanning . . . with an optical image scanner to obtain scanned image data for an image," as set forth in each of independent claims 4 and 11. Based on the Examiner's comments, the Examiner seems to be equating Stess's general disclosure of a digital scanner 51 with an "optical image scanner." Stess merely discloses using a digital scanner to obtain "digital data" relating to the dimensions of the impression shirt. Col. 6, lines 10-31. There is nothing in Stess

providing any express or inherent teaching of the recited “scanning . . . with an optical image scanner to obtain scanned image data for an image.” Stess never mentions or suggests an “optical image” or “scanned image data for an image.” Indeed, Stess’s digital scanner is not described as being an “optical image scanner.” Furthermore, there are many digital scanners that are not optical image scanners (i.e., some scanners using technology without any optical imaging). Moreover, since the purpose of Stess’s disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess’s scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any “image data” for an “image.” For at least these reasons, the rejection of claims 4 and 11 should be withdrawn.

Furthermore, contrary to the Examiner’s allegations, Stess lacks any disclosure of a transfer member placed in contact with “an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4. In the Office Action at page 7, the Examiner apparently alleges that Stess has a transfer member placed in contact with an external body portion “that is inherently capable of including a cosmetic product applied thereto... .” Applicants submit that the Office Action does not set forth a legally proper basis for the inherency-based claim rejection. Speculation about the purported, possible capability of subject matter in a reference does not provide any evidence of inherent disclosure. See M.P.E.P. § 2112(IV). Since the Office Action does not set forth any proper predicate for the inherency allegation, the claim rejection should be withdrawn.

For at least these reasons, the Section 102(e) rejection of claims 4, 7, 8, and 11 based on Stess should be withdrawn.

Claims 4, 6, 37, 46-48, 59, 61, and 62 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,343,536 to Groh ("Groh").

Claims 4, 37, 46, 48, and 59 are the only currently pending, independent claims rejected based on Groh. As explained in more detail below, the Section 102(b) rejection of each of those claims should be withdrawn.

Regarding independent claim 4, Groh does not disclose "placing a transfer member placed in contact with an external body portion . . . including a cosmetic product applied thereto," and "[an] image . . . representative of at least one characteristic of the cosmetic product," as recited in claim 4. In the Office Action at page 5, the Examiner alleges that "[a]ny facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would inherently be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data." Contrary to the Examiner's allegation, Groh does not have any disclosure of placing a transfer member in contact with an external body portion having a cosmetic product applied thereto and, thus, nothing in Groh supports the Examiner's inherency allegation. Moreover, the rejection is flawed even further because it does not satisfy the requirements for a proper inherency-based rejection, as dictated by legal precedent.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities

or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

M.P.E.P. § 2112(IV) (quoting In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d (BNA) 1949, 1950-51 (Fed. Cir. 1999)).

Applicants respectfully submit that the Office Action does not satisfy the burden of establishing inherency because Groh does not necessarily disclose a “transfer member placed in direct contact with an external body portion including a cosmetic product applied thereto,” and an image “representative of at least one characteristic of the cosmetic product,” as recited in independent claim 4. Accordingly, independent claim 4 is patentably distinguishable from Groh.

Concerning independent claim 37, Groh does not disclose “comparing [a] displayed image to at least one image formed from image data stored in an image database,” as recited in claim 37. Contrary to the assertion in the Office Action at page 5, Groh at col. 3, lines 1-32 does not disclose that “[an] image can be compared to at least one other image formed from image data stored in and retrievable from an image database....” Groh merely describes generating data such as size, shape, and total number of comedones, appearing in specimen images (see col. 5, lines 55-60). For at least this reason, independent claim 37 is patentably distinguishable from Groh.

With respect to independent claim 46, Groh does not disclose “displaying an image formed from . . . scanned image data; and viewing the displayed image to analyze . . . at least one characteristic [of an external body portion and/or at least one product],” as claimed. Rather than having any disclosure of such subject matter, Groh describes examining a specimen under a microscope and evaluating the specimen using image analysis hardware and software to determine the number of comedones

existing in the specimen. See Abstract. Examining a specimen with a microscope and evaluating the specimen with image analysis hardware and software is not the same as, and does not result in disclosure of, “displaying an image formed from . . . scanned image data; and viewing the displayed image . . . ,” as recited in independent claim 46. Therefore, independent claim 46 is patentably distinguishable from Groh.

With regard to independent claim 48, Groh does not disclose an “image scanner . . . configured in the form of a scanner for scanning documents,” as recited in the amended language of independent claim 48. One of ordinary skill in the art would understand that Groh’s general description of a digital image analysis apparatus does not disclose a scanner having a document scanning configuration. Accordingly, independent claim 48 is patentably distinguishable from Groh.

Regarding independent claim 59, in the interest of advancing prosecution, Applicants have amended independent claim 59 to remove reference to the image analyzer. Groh does not disclose analysis equipment “chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin.” Consequently, independent claim 59 is patentably distinguishable from Groh.

For at least the reasons explained above, Applicants respectfully submit that the Section 102(b) rejection based on Groh should be withdrawn.

In the Office Action, claims 25-36 and 38-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of an article by Kvedar et al. entitled “Teledermatology in a Capitated Delivery System Using Distributed Information

Architecture: Design and Development” (“Kvedar”). Claims 25 and 38 are the only independent claims included in the Section 103(a) rejection.

Applicants respectfully submit that the Section 103(a) rejection should be withdrawn because neither Groh nor Kvedar, nor any combination thereof, discloses or suggests an “image scanner . . . configured in the form of a scanner for scanning documents,” as recited in the amended independent claims 25 and 38. As discussed above with respect to independent claim 48, Groh does not have any disclosure of an “image scanner . . . configured in the form of a scanner for scanning documents” being used to scan a transfer member. Kvedar lacks any disclosure or suggestion of subject matter remedying that deficiency. Therefore, independent claims 25 and 38 are patentably distinguishable from Groh and Kvedar.

Claims 5-10, 26-36, 39-45, 47, 61-62 depend from independent claims 4, 25, 38, 46, and 48, respectively. Consequently those dependent claims should be allowable for at least the same reasons as the claim(s) from which they depend. Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and allowance of the pending claims.

The Office Action contains a number of statements concerning the claims, disclosure, and cited art. Regardless of whether any such statement is specifically identified herein, Applicants decline to necessarily subscribe to any statement in the Office Action.


If a telephone conversation might advance prosecution, the Examiner is invited to call the undersigned (571-203-2774).

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: July 20, 2006

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